REMARKS

Claims 1, 4-53, 65-73 and 75-76 are pending. Claim 76 is newly added.

Rejection Under 35 U.S.C. 112, 1st Paragraph

Claim 30 is rejected under 35 U.S.C. 112, 1st paragraph, allegedly for failing to comply with the enablement requirement. To support the Office position, the Office has specifically stated that "Applicant's specification teaches the account comprises of several accounts. Therefore, having several accounts in one account is not enabled."

Features of claim 30 are clearly mentioned for example in Figure 3 and associated written description. Figure 3 is labeled as the SYSTEM ARCHITECTURE FOR THE PRESENT INVENTION. As shown, there is an E-Messaging Server 1106; Receives and sends e-messages 1100 and E-Messaging GUI 1136.

Regarding whether having several accounts in one account is enabled, an example is shown in Figure 5b wherein under this account, under the device preference 875, there are a number of examples of sub-accounts identified as email at home 828, email at webmail 829, email at office 831, my web phone 833, my wireless PDA 835, my pager 837, my instant messenger 839, my printer at IP address 841, Internet appliance 843 and fax or phone 845.

Regarding a test of enablement, MPEP 2164.01 has

specifically stated that:

> "Any analysis of whether a particular claim is
> supported by the disclosure in an application requires
> a determination of whether that disclosure, when
> filed, contained sufficient information regarding the
> subject matter of the claims as to enable one skilled
> in the pertinent art to make and use the claimed
> invention. The standard for determining whether the
> specification meets the enablement requirement was
> cast in the Supreme Court decision of Mineral
> Separation v. Hyde, 242 U.S. 261, 270 (1916) which
> postured the question: is the experimentation needed
> to practice the invention undue or unreasonable? That
> standard is still the one to be applied. In re Wands,
> 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir.
> 1988). Accordingly, even though the statute does not
> use the term "undue experimentation," it has been
> interpreted to require that the claimed invention be
> enabled so that any person skilled in the art can make
> and use the invention without undue experimentation.
> In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed.
> Cir. 1988). See also United States v. Telectronics,
> Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed.
> Cir. 1988) ("The test of enablement is whether one
> reasonably skilled in the art could make or use the
> invention from the disclosures in the patent coupled
> with information known in the art without undue
> experimentation."). A patent need not teach, and
> preferably omits, what is well known in the art. In re
> Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed.
> Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies,
> Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir.
> 1986), cert. Denied, 480 U.S. 947 (1987); and
> Lindemann Maschinenfabrik GMBH v. American Hoist &
> Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489
> (Fed. Cir. 1984). >Any part of the specification can
> support an enabling disclosure, even a background
> section that discusses, or even disparages, the
> subject matter disclosed therein. Callicrate v.
> Wadsworth Mfg., Inc., 427 F.3d 1361, 77 USPQ2d 1041
> (Fed. Cir. 2005)(discussion of problems with a prior
> art feature does not mean that one of ordinary skill
> in the art would not know how to make and use this
> feature).< Determining enablement is a question of law

based on underlying factual findings. In re Vaeck, 947
F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991);
Atlas Powder Co. v. E.I. du Pont de Nemours & Co., 750
F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984)."

With regard to the determination of whether that

disclosure, when filed, contained sufficient information

regarding the subject matter of the claims as to enable one

skilled in the pertinent art to make and use the claimed

invention, the answer is yes, because an account comprising sub-

accounts are routinely used in the art and a person of ordinary

skill in the art can readily implement these features. How a

person of ordinary skill in the art would implement these well

known features is omitted because it is the position of the

Federal Circuit that a patent need not teach, and preferably

omits, what is well known in the art.

With regard to the question of what constitutes undue

experimentation, MPEP 2164.01 has stated that:

> "The fact that experimentation may be complex does not
> necessarily make it undue, if the art typically
> engages in such experimentation. In re Certain
> Limited-Charge Cell Culture Microcarriers, 221 USPQ
> 1165, 1174 (Int'l Trade Comm"n 1983), aff'd. sub nom.,
> Massachusetts Institute of Technology v. A.B. Fortia,
> 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also
> In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404. The
> test of enablement is not whether any experimentation
> is necessary, but whether, if experimentation is
> necessary, it is undue. In re Angstadt, 537 F.2d 498,
> 504, 190 USPQ 214, 219 (CCPA 1976).

In implementing accounts within an account feature,

experimentation with programming is needed. However, since

these features are typically implemented with programming,

experimentation with programming is not undue.

For the foregoing reasons, reconsideration and withdrawal

of this rejection are respectfully requested.

Claims 69-70 are rejected under 35 U.S.C. 112, 1st

paragraph, allegedly for failing to comply with the written

description requirement.

In supporting this rejection, the Office has positively

stated that:

> "The claim(s) contains subject matter which was not
> described in the specification in such a way as to
> reasonably convey to one skilled in the relevant art
> that the inventor(s), at the time the application was
> filed, had possession of the claimed invention.
> Applicant specification teaches email account used for
> the delivery of the result. However, the
> specification does not teach use of email alias
> account wherein the aliases are deleted from the
> account once a predetermined time has expired."

Contrary to the conclusion reached by the Office, the

subject matter of claim 69 is mentioned for example in Figure 3

labeled as the SYSTEM ARCHITECTURE FOR THE PRESENT INVENTION and

associated written specification. As shown, there is a link

between Information Request GUI 1102 and Information Request

Application Server 1130. It is described as "send requests and

receives updates" in Figure 3.

Another example that supports this feature is disclosed on

page 12, lines 15-25, which states in its entirety that:

> "   This method and system takes conventional opt-in
> or permission-based e-mail to a new dimension in
> dynamic user control and specificity and may be
> rightly termed a new form of "on request," user-
> controlled information access utility. With the
> ability, in particular, to control duration of active
> requests (in hours, days, weeks, months, or no time
> limit), frequency, and quantity of desired
> information, specific time period and other factors,
> the system provides a more effective method of "just-
> in-time e-marketing communication" for users who are
> closer to the "purchase decision window" able, willing
> and ready to transact."

It is readily understood by a person of ordinary skill in

the art that a permission-based email with the ability to

control duration of frequency, quantity and specific time period

is implemented by an email alias with time expiration. In SMTP

protocol, email alias is mapped to a single email address. To

associate different permissions for different email senders from

an email recipient's point of view, recipient email alias is

used. Therefore, all features of claim 69 are supported as

would be recognized by a person of ordinary skill in the art.

Regarding claim 70, the Office has alleged that "the

specification does not teach relational database". Again,

contrary to the Office position, the subject matter of claim 70

is for example disclosed in Figures 1, 2, 3 and associated

written description. Figure 1 is labeled as the ACCOUNT-BASED

INFORMATION CONTROL AND EXCHANGE UTILITY. Figure 2 is labeled

as an ACCOUNT-BASED ON REQUEST INFORMATION CONTROL AND EXCHANGE

UTILITY, and Figure 3 is labeled as the SYSTEM ARCHITECTURE FOR

THE PRESENT INVENTION.

Relevant portions of Figures 1-3 where a person of ordinary

skill in the art would recognize existence of relational

databases are the information memory system 106, DBMS 1120, the

information memory system 106, the system data warehouse 234,

the central marketer email inventory db 216, the 3rd party

inventory DB 212 and the subscriber dynamic request database

202.

For the foregoing reasons, reconsideration and withdrawal

of this rejection are respectfully requested.

Rejection Under 35 U.S.C. 112, 2nd Paragraph

Claims 1 is rejected under 35 U.S.C. 112, second paragraph,

alleged as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant

regards as the invention.

In making this rejection, the Office raised many questions.

The Applicant hereby attempts to answer them herein below. With

regard to the question that "it is unclear how the storing of

the result of a request, influences the decision of an

individual", claim 1 is amended to remove this language. Hence,

this issue is rendered moot.

With regard to the question that "it is unclear to the Examiner how an action taken could be "not made a purchase" or "purchased within a time range" or "abandoned the request". An answer to this question is already explained by way of an example on page 11, lines 7-20 of the written specification, which is reproduced herein below:

"   The present invention acts as an information exchange system, which seeks to optimize the matching up of the requests from multiple users for information with their associated multiple criteria/preferences and personal profiles on the one hand, with, on the other hand, the information inventory of multiple suppliers' with their associated multiple specifications, objectives and mandatories. In this embodiment, the user or subscriber has an Information Account and the Supplier or Information Provider has an Information Account each of which maintains active and historical records of requests made, criteria for such requests and a record of delivered results and associated email behaviors and financial transactions as appropriate."

Examples of more detailed answers to this question can be found between page 50, line 4 and page 51, line 4 of the written specification, which are reproduced hereinbelow:

"Figure 10 illustrates a sample at your request user history record 1000. This record contains two windows 1001 and 1003. Window 1001 contains a user identifier area 1002 recording the email address of the user. Below the identifier area 1002 is an at my request summary statement 1004, which is temporarily left blank for this user.
    Regarding search events, there is a search category 1010 indicating a search of a Caribbean Trip 1012. The request of the search has a starting date 1008 on August 1, 2000 and an ending date 1016 on August 10, 2000.

There is a summary of items sent 1018 recording
all results that have been sent. Adjacent to this
summary is a summary action 1020 recording how the
search result is treated by the user. As illustrative
examples, item 1022 indicates result of an Empire
Travel 0745112 delivered on August 1 that was deleted
without opening. Item 1024 indicates result of an
American Express 7544117 delivered on August 2 that
was opened and deleted. Item 1026 indicates result of
an American Airline 6744112 delivered on August 2 that
was opened and forwarded to john@aol.com. Item 1028
indicates a Continental Air 6441178 delivered on
August 2 that was opened, responded and forwarded to
betty@idt.net. Item 1030 indicates a request that was
deleted before any result is delivered.
     Window 1003 is the history record for a second
user request."

Therefore, how a user utilizes the information is recorded

in a historical record. Figure 9c shows another example

entitled "AT MY REQUEST"-SUPPLIER PERFORMANCE & RESULTS ANALYSIS

INTERFACE. At the Recipient Behavior Summary 1638, there is a

summary item for purchases 1648 made in current year 1615 and

prior year 1617. At the Transaction Summary 1603, there is also

a summary item of gross purchases made 1611.

With regarded to the Office question that it "is unclear

how the determination of the level of readiness to buy or the

purchase or usage intentionality is made based on the collected

result. In other word there is no indication that the

information collected provides the level or readiness or

intentionality of the user", this is a question based on an

incorrect understanding of the claimed invention. Please note

claim 10 specifies inputting information associated with one of

various levels of readiness to by and a purchase intentionality

index. Claim 11 states <u>entering</u> information associated with one

of a usage intentionality index.

Therefore, the claim merely states inputting and entering

different information. They never stated that the level of

readiness to buy or the purchase or usage intentionality is

determined based on a post-searched collected result.

Claim 47 is amended to remove the Office alleged lack of

antecedent basis element.

In claim 74, the Office alleged lack of antecedent basis

element is not present. Hence, the claim is not amended.

For the foregoing reasons, reconsideration and withdrawal

of this rejection are respectfully requested.

Rejection Under 35 U.S.C. 102

Claims 1, 4-5, 7-13, 15-17 21-24, 28-39, 41-45, 49, 65-67

and 73-75 were rejected under 35 U.S.C. 102(e) as being

anticipated by Chern et al. (U.S. Patent No. 6,381,456). This

rejection is traversed for reasons stated herein below.

Independent claim 73 has positively stated a feature of

"inputting an information indicative of a level of readiness to

buy". To fulfill this step, there must be an input of an

information specifically indicative of a level of readiness to

buy.

Independent claim 74 has positively stated a feature of

"inputting an information indicative of a purchase

intentionality". To fulfill this step, there must be an input

of an information specifically indicative of a purchase

intentionality.

In rejecting these features of independent claims 73 and

74, the Office stated that "Chern teaches user selecting

promotions or sales notification, which indicates that the user

readiness or purchase or usage intentionality (see col. 12 lines

4-43). Column 12, lines 4-43 of Chern states in its entirety

that:

> "If the user has selected news notifications, the
> method proceeds to step 694. Server 136 obtains search
> parameters to define the types of news notifications
> provided to the user, such as the news type (i.e.,
> politics, sports, headlines, entertainment, etc.) or
> region (city, county, state, national, world). These
> parameters may have already been retrieved by server
> 136 from handset 130 in steps 606-610 of FIG. 8. If
> not, the user may be prompted at step 694 to enter
> search parameters. At step 696, server 136 searches
> for news that falls within the search parameters.
> If the user has selected event notifications, the
> method proceeds from node 692 to step 698. Server 136
> obtains search parameters to define the types of event
> notifications provided to the user. Parameters may
> include the event type (i.e., community events,
> sporting events, theatre, arts, etc.), events within a
> certain region (city, county or state), or events
> occurring within a configurable mile radius of the
> user. These parameters may have already been retrieved
> by server 136 from handset 130 in steps 606-610 of
> FIG. 8. If not, the user may be prompted at step 698
> to respond to queries to define the search parameters.
> At step 700, server 136 searches for events that fall
> within the search parameters.

"If the user has selected promotion or sales notifications, the method proceeds from node 692 to step 702. Server 136 obtains search parameters to define the types of promotional or sales notifications provided to the user. Parameters may include merchant or service type (i.e., clothing, household goods, restaurants, etc.), or promotions/sales occuring within a defined region or configurable mile radius of the user. These parameters may have already been retrieved by server 136 from handset 130 in steps 606-610 of FIG. 8. If not, the user may be prompted at step 702 to respond to queries to define the search parameters. At step 704, server 136 searches for events that fall within the search parameters.

Once server 136 has retrieved all subscribed notifications matching the search parameters, it proceeds to node 706 and determines whether the notifications found in the search were already sent to the user. If the notifications were already sent, it is usually not necessary or desirable to send them to the user again, and the server proceeds directly to step 712. It should be noted, however, that the user may set her preferences to eliminate this step if she wishes to receive all notifications found, even if they were previously sent. If the notifications have not yet been sent to the user, the notifications are sent to handset 130 over network 140 (step 708). The notifications may be sorted according to the user's preferences such as, for example, by region, proximity, price, merchant-type and so on. At step 710, handset 130 displays the received and sorted notifications."

In the Office relied portion of Chern, there is simply no disclosure or teaching of inputting an information specifically indicative of a level of readiness to buy as positively recited in claim 73. There is also no disclosure or teaching of inputting an information specifically indicative of a purchase intentionality as positively recited in claim 74.

It is well settled that:

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"A claim is anticipated only if each and every element
as set forth in the claim is found, either expressly or
inherently described, in a single prior art reference."
Constant v. Advanced Micro-Devices, Inc., 848 F.2d
1567, 7 USPQ2d 1057 (Fed. Cir. 1988).

Since Chern fails to disclose each and every element as set

forth in claim 73 and 74, independent claims 73-74 of the

present invention are not anticipated by Chern.

Independent claim 1 has been amended to further include

"wherein the network keeps an identity of an user of the

Information account confidential until the user discloses the

identity to the supplier". These features are not disclosed or

taught in Chern.

By so amending, independent claims 1 is placed in condition

for allowance.

All claims dependent thereon independent claims 1 and 73-

74, by virtue of inherency, are also in condition for allowance.

Reconsideration and withdrawal of this rejection are

respectfully requested.

Rejection Under 35 U.S.C. 103

Claims 6, 18, 47, 50, 69 and 70 were rejected under 35

U.S.C. 103(a) as being unpatentable over Chern et al. (U.S.

Patent No. 6,381,456) and further in view of Official Notice.

In the rejection, the Office has stated that "Regarding

claim 6, Chern does not teach determining an actual duration of

the request stayed active"; "Regarding claim 18, Chern does not explicitly teach entering the quantity of information desired as expressed in on of fixed number and range"; "Regarding claim 47, Chern does not explicitly teach automatic forwarding of emails"; "Regarding claim 50, Chern does not teach capturing requester behavior with respect to the result as one of opening the result, saving or deleting etc."; "Regarding claim 69, Chern does not explicitly teach email alias account that expires after a predetermined time"; "regarding claim 70, Chern teaches databases however does not explicitly teach storing computer table in a relational database".

The Applicant agrees with these Office assessed shortcomings of Chern et al. However, the Office has taken Official Notice that what Chern et al. fails to disclose or teach are old and well known.

Old and well-known features should be easy to find in the prior art. A copy of the prior art that either teach or disclose each of these shortcomings is respectfully requested.

Should the Examiner insist upon asserting Official Notice instead of asserting prior art reference for each of these old and well known features, observance of 37 CFR §1.104(d)(2) is respectfully requested. Section 1.104(d)(2) has specifically stated in its entirety that:

"When a rejection in an application is based on facts
within the personal knowledge of an employee of the
Office, the data shall be as specific as possible, and
the reference must be supported, when called for by
the applicant, by the affidavit of such employee, and
such affidavit shall be subject to contradiction or
explanation by the affidavits of the applicant and
other persons."

Therefore, it is the requirement of the Code of Federal

Regulations that when a rejection in an application is based on

facts within the personal knowledge of an employee of the

Office, the data shall be as specific as possible, and the

reference <u>must</u> be supported, when called for by the applicant,

by the <u>affidavit</u> of such employee, and such affidavit <u>shall</u> be

subject to contradiction or explanation by the affidavits of the

applicant and other persons.

In the instant application, an Office employee has made

certain personal knowledge assertions without presenting any

support thereof so that one can objectively evaluate the

authenticity, authoritativeness, relevancy, thoroughness,

integrity, probative value and accuracy of the asserted personal

knowledge that is used to reject the claimed invention. Without

ascertaining such support, it is not understood how the

substantial evidence test is satisfied in rejecting the claimed

invention. Therefore, in full compliance with this section, the

Applicant respectfully requests an affidavit from the Office

employee making the personal knowledge assertion so that any

contradiction or explanation can be prepared by the Applicant or other persons.

Claims 14, 19-20, 25-27, 46, 53, 68 and 71-72 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cherns et al. (U.S. Patent No. 6,381,456) and further in view of O'Flaherty et al. (U.S. Patent No. 6,253,203).

As mentioned above, independent claims 1 and 73-74 are in condition for allowance. All claims dependent thereon, by virtue of inherency, are also in condition for allowance.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 40, 48, and 51-52 were rejected under 35 U.S.C. 103(a) as being unpatentable over Chern et al. (U.S. Patent No. 6,381,456) and further in view of Bisdikian et al. (U.S. Patent No. 5,974,406).

As mentioned above, independent claims 1 and 73-74 are in condition for allowance. All claims dependent thereon, by virtue of inherency, are also in condition for allowance.

Reconsideration and withdrawal of this rejection are respectfully requested.

New Claim

Independent claim 76 is added herein by amendment. An email account feature is added. Entry and allowance of this new claim are respectfully requested.

CONCLUSION

Should a personal interview be needed to advance the prosecution of the present application, the Examiner is invited to contact the undersigned attorney.

The Commissioner is hereby authorized to charge any underpayment of fees or credit any overpayment of fees in connection with this communication to Deposit Account 50-2840.

Respectfully submitted,
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